

REMARKS

In the Office Action¹, the Examiner took the following actions:

- 1) rejected claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application No. US 2003/0065774 to Steiner et al. ("Steiner") in view of U.S. Patent No. 6,625,595 to Anderson et al. ("Anderson"); and
- 2) rejected claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Steiner and Anderson in view of U.S. Patent No. 6,327,590 to Chidlovskii et al. ("Chidlovskii").

Rejection of Claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Steiner in view of Anderson. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

A *prima facie* case of obviousness has not been established because, among other things, neither Steiner nor Anderson, nor their combination, teaches or suggests each and every element of Applicants' claims.

Claim 1 calls for a combination including, for example, "search condition item extracting means for extracting at least one of an information item . . . and a value of the information item." Steiner fails to teach or suggest the search condition item extracting means of claim 1.

The Examiner argues that the above-quoted element of claim 1 is taught by Steiner in paragraphs 0039-0041. See Office Action, page 3. The Examiner apparently characterizes the search broker of Steiner as corresponding to the claimed search condition item extracting means. However, "the search broker determines candidate resource providers." Steiner, para. 0039. Accordingly, the output of the search broker of Steiner is resource providers, not the search results. In fact, in Steiner, "[t]he resource providers deliver the search results directly to the original requester." Steiner, para. 0041. The search broker of Steiner does not send the search results to the original requester. Therefore, Steiner does not disclose "search condition item extracting means for extracting at least one of an information item . . . and a value of the information item," as recited in claim 1.

Furthermore, claim 1 calls for the combination including, for example, "search condition item extracting means for . . . notifying the agent of at least one of the information item extracted and the value extracted." Steiner fails to teach or suggest the search condition item extracting means of claim 1.

According to an embodiment of the present invention, the search condition item extracting means also acquires other resource descriptions registered corresponding to the service found using the resource contained in a search request. See, e.g., Spec., page 22, lines 16-21; page 25, line 1 to page 27, line 2. For example, if an agent searches for services using "Number of Accommodation Days" as a resource description and the search unit accordingly detects Service A in the registry, the search unit also returns other resource descriptions, such as, "Number of Persons", "Number of rooms", "Room Type", etc. See Fig. 10; page 26, lines 2-11.

In the previous Office Action, the Examiner stated that Steiner teaches, "[r]esource query data type . . . contains search terms which must be extracted as they are sent from requester to search broker." See Office Action mailed June 13, 2006, page 8. However, Steiner does not disclose that other resource descriptions (search terms) that are held by a broker and are not included in a resource description sent by a requester are also returned to the requester.

Furthermore, the Examiner admits that, in Steiner, "search terms . . . are sent from requester to search broker and from search broker to resource provider." See Office Action mailed June 13, 2006, page 8. Steiner does not teach or suggest that the search terms are sent from the search broker to the requester. Moreover, there is no mention in Steiner that additional search terms (those not provided by the requester) could be sent to the requester from the search broker. Therefore, Steiner does not disclose "search condition item extracting means for . . . notifying the agent of at least one of the information item extracted and the value extracted," as recited in claim 1.

For at least the reasons set forth above, Steiner fails to teach or suggest “search condition item extracting means” of claim 1. In addition, the Examiner cited Anderson as a teaching of “the search unit outputs the result of the search to the search condition item extracting means when the result of the search specifies a larger number of information services than a specified number of information services,” as recited in claim 1. Even assuming that the Examiner’s characterization of Anderson is correct, Anderson fails to cure the deficiencies of Steiner, discussed above. That is, Anderson, also, fails to teach or suggest “search condition item extracting means” of claim 1. Accordingly, Steiner and Anderson, taken either alone or in any reasonable combination, fail to teach or suggest each and every element of claim 1.

Claim 2 depends from claim 1 and is distinguishable from Steiner and Anderson at least by virtue of its dependence from allowable base claim 1. Additionally, Steiner fails to teach or suggest “the search condition item extracting means classifies, by common category, . . . the information item names,” as recited in claim 2.

The Examiner argues that paragraphs 0041 and 0076 of Steiner teach the above-quoted element of claim 2. Applicants respectfully disagree. The cited portions of Steiner teach classifying resource providers together based on same resource description. See Steiner, para. 0076. For example, ResourceProvider 003 and ResourceProvider 004 in Steiner are classified together because they both have the same ResourceDescription of “Travel.” See Steiner, Table 3. Steiner does not teach or suggest classifying resource descriptions into common categories.

In an exemplary embodiment of claim 2, different item names: “Number of accommodation days”, “Number of days”, “Number of accommodations”, “Number of

staying nights”, and “Number of staying days”, would all be classified together into one common category because they share the same meaning. See Spec., page 27, lines 3-9.

Accordingly, in Steiner, services are classified into categories, whereas in the exemplary embodiment above of the present invention, various search terms contained in a service description are classified into categories. Therefore, Steiner does not disclose “the search condition item extracting means classifies, by common category, . . . the information item names,” as recited in claim 2.

Claim 3 depends from claim 2 and is distinguishable from Steiner and Anderson at least by virtue of its dependence from allowable base claim 1 and allowable intermediary claim 2. Additionally, Steiner fails to teach or suggest “the search condition item extracting means uses ontology trees to classify, by common category, . . . the information item names,” as recited in claim 3.

As discussed above, because “the search condition item extracting means uses ontology trees to classify, by common category, . . . the information item names,” descriptions such as “Travel”, “Trip”, and “Tour” would be categorized into one common category.

However, in Table 3 of Steiner, it may be impossible to make “Trip” or “Tour” correspond to ResourceProvider 003 and ResourceProvider 004 which provide services related to “Travel.”

On the other hand, according to an embodiment of the present invention, ResourceProvider 003 and ResourceProvider 004 of Steiner, in which a description of “Travel” is registered, could be made to correspond even to “Trip” or “Tour.”

Accordingly, Steiner does not disclose “the search condition item extracting means uses ontology trees to classify, by common category, . . . the information item names,” as recited in claim 3.

For at least the reasons set forth above, Steiner and Anderson fail to support a *prima facie* case of obviousness with respect to claims 1-3. Furthermore, claims 6-8 and 11-13, although different in scope from claims 1-3, recite elements similar to those discussed above with respect to claims 1-3. Therefore, claims 6-8 and 11-13 are also allowable over Steiner and Anderson. The rejection of claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Steiner in view of Anderson is thus improper and should be withdrawn.

Rejection of Claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a) as being unpatentable from Steiner and Anderson in view of Chidlovskii. A *prima facie* case of obviousness has not been established because, among other things, neither Steiner, Anderson, nor Chidlovskii, nor their combination, teaches or suggests each and every feature of Applicants' claims.

As noted above, Steiner and Anderson fail to teach all the elements of independent claims 1, 6, and 11. Chidlovskii fails to cure this deficiency. That is, Chidlovskii also fails to teach or suggest “search condition item extracting means” of claim 1, which is required by dependent claims 4, 5, 9, 10, 14, and 15. For at least this reason, Steiner, Anderson, and Chidlovskii fail to support a *prima facie* case of obviousness with respect to claims 4, 5, 9, 10, 14, and 15. The rejection of claims 4, 5,

9, 10, 14, and 15 under 35 U.S.C. §103(a) as being obvious from Steiner and Anderson in view of Chidlovskij is thus improper and should be withdrawn.

Conclusion

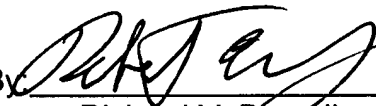
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By  #27432
for Richard V. Burgujian
Reg. No. 31,744